UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,443	10/12/2001	Ronald E. Sloan	60021-376002	2727
29838 7590 07/24/2008 OPPENHEIMER WOLFF & DONNELLY, LLP PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609			EXAMINER	
			NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3692	
			MAIL DATE	DELIVERY MODE
			07/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)				
	09/976,443	SLOAN ET AL.				
Office Action Summary	Examiner	Art Unit				
	Nga B. Nguyen	3692				
The MAILING DATE of this communication app	ears on the cover sheet with the c	orrespondence address				
Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 28 Ap	oril 2008.					
	action is non-final.					
3) Since this application is in condition for allowar						
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4)⊠ Claim(s) <u>25-41</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>25-41</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or election requirement.						
Application Papers						
9)☐ The specification is objected to by the Examine	r.					
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment/c)						
Attachment(s) 1) \(\sum \) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate				
3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/2/08</u> .	5) Notice of Informal P 6) Other:	ацепт Арріісатіоп				

Application/Control Number: 09/976,443 Page 2

Art Unit: 3692

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 28, 2008 has been entered.

2. Claims 25-41 are pending in this application.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on May 2, 2008 was filed is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments/Amendment

4. Applicant's arguments with respect to claims 25-41 have been fully considered but are most in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Application/Control Number: 09/976,443 Page 3

Art Unit: 3692

6. Claims 25-31 and 37-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 25-31 discuss methods, however, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class, such as a particular apparatus, or (2) transform underlying subject matter, such as an article or materials, into a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n. 9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70-71 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). In claims 25-31, the applicant claims a method for providing automated coaching for a financial modeling, but does not tie the method to any other statutory subject matter, such as a computer platform, to perform the steps detailed in claims 25-31. Therefore, claims 25-31 are non-statutory.

Claims 37-41 recite "a computer program", are non-statutory, because they are directed solely to Functional Descriptive Material *Per Se*.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman, U.S. Patent No. 6,601,044.

Regarding to claims 32-36, Wallman discloses a system comprising: a database **for** receiving financial data, a processing unit **for** processing financial data, and a user interface **for** outputting to the user-investor (column 28, lines 10-40).

Examiner submits that the claimed invention recites <u>an intended use</u>, although Wallman fails to discuss the intended use recited in the claimed invention, Wallman's computer system is capable of performing the intended use recited in the claimed invention. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wallman's to include the intended use features recited in the claimed invention for the purpose of providing automated coaching for a financial modeling and counseling in a specific way.

"The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

- 9. Claims **25-41** are rejected.
- 10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

Art Unit: 3692

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(703) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 09/976,443 Page 6

Art Unit: 3692

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/ Primary Examiner, Art Unit 3692

July 15, 2008